

Remarks

I. Interview Summary Records

A. Telephone Conference between Examiner Mark Henderson and Edouard Garcia

In a telephone conference on January 19, 2005, the Examiner and Mr. Garcia reviewed the analytical basis for the Examiner's rejection of claims 1-12, 20-26, and 32-36 in his actions dated June 16, 2004, and December 2, 2004. In particular, Mr. Garcia pointed out that none of these claims is a product-by-process claim and, consequently, the analytical framework relied upon by the Examiner for interpreting these claims was incorrect. At the conclusion of the telephone conference, the Examiner acknowledged to Mr. Garcia that claims 1-12, 20-26, and 32-36 are not product-by-process claims and that the Examiner's basis for rejecting these claims would have to be changed or these claims would have to be allowed. The Examiner also indicated that his supervising primary Examiner had agreed that claims 1-12, 20-26, and 32-36 were not product-by-process claims.

In addition, the Examiner and Mr. Garcia discussed the specific language of independent claim 1. In particular, the Examiner indicated that if the features describing the way in which the cover content layout engine composes the final content layout for the cover were written as direct actions of the cover content layout engine, he would give patentable weight to these features and would not resort to some sort of "intended use" analysis of the claim language.

B. Telephone Conference between Examiner Derris Banks and Edouard Garcia

On January 30, 2005, Mr. Garcia sent the following e-mail message to Examiner Derris Banks, who is the supervisory Examiner for Art Unit 3700.

Dear Examiner Banks:

I have prepared the following summary to assist you in your review of the file history for the above-identified patent application.

I. Pending claims

Claims 1, 8, 10, 13, and 18-20 are independent claims.

Claims 2-7, 9, 11, 12, and 21-26 depend from independent claim 1.

Claims 14-17 and 27-31 depend from independent claim 13.

Claims 32-36 depend from independent claim 20.

II. Status of claims

In the Final Office action dated 12/2/04, Examiner Henderson allowed claims 13-19 and 27-31 and rejected the remaining claims.

III. Summary of the pertinent parts of the file history

Independent claims 1 and 20 recite apparatus elements that are configured to implement all of the features recited in allowed independent claim 13.

In the Office action dated 6/16/04, Examiner Henderson took the incorrect position that independent claims 1 and 20 were product-by-process claims. On this basis, Examiner Henderson concluded that he could ignore the functionality of the apparatus elements of claims 1 and 20 that implement the features recited in allowed claim 13. From this analysis, Examiner Henderson concluded that claims 1 and 20 could be rejected under 35 U.S.C. 102 over Michaelis (US 2002/0057453) and Kosasa (US 5,753,659), respectively, whereas independent claim 13 was allowable over these same references.

In the Response dated 8/16/04 – which did not amend any of the pending claims – Applicants explained that claims 1 and 20 were not product-by-process claims and, therefore, Examiner Henderson's basis for rejecting these claims and their corresponding dependent claims was improper.

In his next action dated 12/2/04, Examiner Henderson maintained that his product-by-product claim analysis was

indeed proper. In reliance at least in part on this basis, Examiner Henderson made the action final.

After I spoke with Examiner Henderson on 1/19/05, Examiner Henderson agreed that his application of a product-by-process claim analysis to independent claims 1 and 20 was improper.

During our conversations on 1/19/05, Examiner Henderson also expressed a belief that he could still ignore the functionality of the apparatus elements recited in claims 1 and 20 using some sort of "intended use" analysis. I explained to Examiner Henderson, however, that claims 1 and 20 did not recite the functionalities of these apparatus elements in terms of an "intended use"; rather, the functionalities of these claim elements is recited in terms of "being configured to", which does not connote an intended use. As is well-known, an "intended use" is expressed by a word such as "for", not "configured to".

IV. Applicants' position

Applicants contend that they are entitled to an equitable and proper examination of their claims. If Examiner Henderson had properly considered all of the features recited in claims 1 and 20 in the non-final action dated 8/16/04 he necessarily would have had to allow these claims for at least the same reasons that he allowed independent claim 13. Instead, Examiner Henderson repeatedly relied on an improper analysis of claims 1 and 20 to justify making the action dated 12/2/04 final.

Since the basis for Examiner Henderson's making the action dated 12/2/04 final was improper, Applicants' ask that the finality of this action be withdrawn.

If the finality of the action dated 12/2/04 is not withdrawn, Examiner Henderson would not be required to give due consideration to the response that Applicants would file in reply to this action. Examiner Henderson could simply issue an Advisory action and Applicants would not have received a proper examination of independent claims 1 and 20 (and their dependent claims), nor would they have been given a fair opportunity to reply to the "true basis" (if any) for Examiner Henderson's rejection of these claims. Instead, Applicants' only recourse would be to file a costly Appeal or a costly RCE.

For these reasons, Applicants believe that fairness and equity require that the finality of Examiner Henderson's action dated 12/2/04 be withdrawn.

On February 1, 2005, Mr. Garcia called Examiner Banks to discuss the above-quoted e-mail message. During this conversation, Examiner Banks told Mr. Garcia that if Applicants responded to the Office action dated December 2, 2005, and Examiner Henderson revoked the allowance of the method claims 13-19 and 27-31 in a subsequent action, Examiner Banks would not permit that subsequent action to be made final.

II. Status of claims

Claims 1-36 are pending.

Claims 13-19 and 27-31 have been allowed.

Claims 1, 2, 6-10, 12, 20-26, and 32-36 have been amended. In particular, instances of "configured to" language describing operational capabilities of elements of these claims have been replaced with language describing the actions performed by these elements. As explained above, the Examiner has indicated that he would give this type of language patentable weight when construing the claims.

III. Claim rejections under 35 U.S.C. § 102

A. Claims 1, 2, 4, 8 and 21

Claims 1 and 8 are independent claims. Claims 2, 4, 8, and 21 depend from independent claim 1.

Claim 1 recites a cover authoring tool that comprises an interface that receives content information for at least a front region and a spinal region of a cover, and a cover content layout engine that composes a final content layout for the cover, wherein the cover content layout engine scales content received for the front cover region and formats content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon document size information and the cover content information received through the interface.

The Examiner has rejected claims 1, 2, 4, 8 and 21 under 35 U.S.C. § 102(e) over Michaelis (U.S. 2002/0057453).

The Examiner has failed to point to any teaching or suggestion in Michaelis of a cover authoring tool that comprises a cover content layout engine that composes a final layout for the cover, wherein the cover content layout engine scales content received for the front cover region and formats content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon document size information and cover content information received through the interface, as recited in claim 1.

Indeed, in Michaelis' approach, the page size and the cover size for a book are predetermined for a given book title. Michaelis' system prints an image on the cover of a given book at a position that is shifted laterally by an amount needed to accommodate the slight difference between the measured caliper for the given book and a pre-stored nominal caliper value for the particular book title corresponding to the given book (see, e.g., ¶ [0019]). That is, Michaelis' system laterally shifts cover images slightly to the left or right based solely on the slight difference between the measured caliper for the given book and a pre-stored nominal caliper value for the particular book title. Therefore, Michaelis' system does not scale content received for the front cover region, as recited in claim 1.

In addition, Michaelis does not even hint that his system formats content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine. Michaelis' system merely adjusts the cover printing process based solely on the slight difference between the measured caliper for the given book and a pre-stored nominal caliper value for the particular book title. Therefore, Michaelis' system does not even consider the height dimension of the book spine when adjusting the cover printing process.

For at least these reasons, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 102(e) over Michaelis now should be withdrawn.

Each of claims 2, 4, 8, and 21 incorporate the features of independent claim 1 and therefore is patentable over Michaelis for at least the same reasons explained above.

B. Claims 20 and 32-36

Claim 20 is an independent claim and claims 32-36 depend from claim 20.

Independent claim 20 recites a bookbinding system that comprises a cover authoring tool that comprises an interface that receive content information for at least a front region and spinal region of the cover, and a cover content layout engine that composes a final content

layout for the cover, wherein the cover content layout engine scales content received for the front cover region and formats content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon received document size information and received cover content information. Claim 20 also recites that the bookbinding system comprises a cover binder that attaches the cover to the text body.

The Examiner has rejected claim 20 under 35 U.S.C. § 102(b) over Kosasa (U.S. 5,735,659).

Kosasa, however, does not teach or suggest anything about a cover binder that attaches to a text body a cover having a front content region and a spinal content region, as recited in claim 20. Instead, Kosasa merely discloses a binding apparatus that binds a set of sheets with a length of binding tape 77 that is applied to the spine of the sheet set S1, as shown in FIG. 2B (see, e.g., col. 4, line 57, through col. 5, line 5).

In addition, Kosasa fails to teach or suggest anything about a cover authoring tool that includes an interface that receives content information for at least a front region of a cover and a cover content layout engine that composes a final content layout for the cover, wherein the cover content layout engine scales content received for the front cover region, as now recited in claim 20. Indeed, since Kosasa's system does not handle covers with front content regions, there is no need whatsoever for Kosasa's system to receive content information for a front region of such a cover or to scale the received front cover content.

For at least the reasons explained above, the Examiner's rejection of independent claim 20 under 35 U.S.C. § 102(b) over Kosasa now should be withdrawn.

Each of claims 32-26 incorporates the features of independent claim 20 and therefore is patentable over Kosasa for at least the same reasons.

IV. Claim rejections under 35 U.S.C. § 103

A. Claim 3

Claim 3 incorporates the features of independent claim 1.

The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) over Michaelis in view of Carlson (WO 01/00423).

Carlson, however, does not make up for Michaelis' failure to teach or suggest a cover authoring tool comprising a cover content layout engine that composes a final content layout for the cover, wherein the cover content layout engine scales content received for the front cover region and formats spinal region content to accommodate the width and height dimensions of the book spine based upon document size information and cover content information received through an interface, as recited in claim 1. Indeed, Carlson's system does not receive any cover content whatsoever. Instead, a user must add cover content manually using a separate system (see, e.g., page 17, lines 9-15).

Therefore, for at least the reasons explained above, the Examiner's rejection of claim 3 under 35 U.S.C. § 103(a) over Michaelis in view of Carlson now should be withdrawn.

B. Claims 5-7

Each of claims 5-7 incorporate the features of independent claim 1.

The Examiner has rejected claims 5-7 under 35 U.S.C. § 103(a) over Michaelis in view of Tonkin (U.S. 6,616,702). Tonkin, however, does not make up for Michaelis' failure to teach or suggest a cover authoring tool that comprises a cover content layout engine that composes a final content layout, wherein the cover content layout engine formats content received from the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon document size information and cover content information, as recited in claim 1. Indeed, Tonkin's system does not receive any spinal cover content and, therefore, Tonkin does not even hint that his system could be configured to format content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine.

For at least the reasons explained above, the Examiner's rejection of claims 5-7 under 35 U.S.C. § 103(a) over Michaelis in view of Carlson now should be withdrawn.

C. Claims 9-12

Claims 9, 11, and 12 incorporate the features of independent claim 1, and claim 10 is an independent claim.

The Examiner has rejected claims 9-12 under 35 U.S.C. § 103(a) over Michaelis in view of Kosasa.

Regarding claims 9, 11, and 12, Kosasa does not make up for Michaelis' failure to teach or suggest a cover authoring tool that comprises a cover content layout engine that composes a final content layout for the cover, wherein the cover content layout engine scales content received for the front cover region, as recited in claim 1. Indeed, as explained above in connection with independent claim 20, Kosasa's system does not handle a book cover having a front content region. For this reason, Kosasa's system does not receive any content whatsoever for a front region of such a cover.

Claim 10 recites a cover authoring tool that comprises a cover content layout engine that selects typeface parameter values for spinal text content consisting of a number of characters based at least in part upon the number of characters of spinal text content and the height and width dimensions of the book spine. The Examiner has acknowledged that neither Michaelis' system nor Kosasa's system selects typeface parameter values for spinal text content based at least in part upon the number of characters of spinal text content and the height and width dimensions of the book spine. Therefore, no permissible combination of Michaelis and Kosasa could possibly render obvious the invention recited in claim 10.

For at least the reasons explained above, the Examiner's rejection of claims 9-12 under 35 U.S.C. § 103(a) over Michaelis in view of Kosasa now should be withdrawn.

V. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

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Respectfully submitted,

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